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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/590,512 | 02/29/2008 | Takehiro Matsumoto | 47487-0003-00-US | 1013 |

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| EXAMINER | |
|---|---|
| WILLIAMS, LELA | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1787 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 05/12/2010 | ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DBRIPDocket@dbr.com
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| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/590,512 | MATSUMOTO ET AL. | |
| | Examiner | Art Unit | |
| | LELA S. WILLIAMS | 1787 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *29 February 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *2/29/2008*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 10, 12, and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claims 10, 12, and 14 state "allowing" language. What does "allowing" the beverage to contain, fruit juice, an extract of herb, and carbonic acid mean? It is not clear if the beverage contains said ingredients or not. Given that all the said ingredients are known to be used in beverages and are GRAS, they are allowed for use.

Claim 14 also states "a carbonic acid." The usage of "a" is confusing given that it implies carbonic acid is a generic term and there is more than one carbonic acid to choose from.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**7. Claims 1-6, 9-13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suntory News Release No. 8691 in view of Herraiz et al., *"Analysis of wine distillates made from Muscat grapes (Pisco) by multidimensional gas chromatography and mass spectrometry."***

**Regarding claims 1, 3-6**, Suntory discloses a liquor product wherein maca and rose hip are infused in Andes white grape distilled spirits and finished with lime and lemon juice. The press release is silent to the use of Muscat grapes and the content of acetic acid with respect to the amount of pure alcohol therein. Muscat grapes are known to be used in the art, and as disclosed by Herraiz, Pisco, a beverage obtained by distillation of wine made from Muscat grapes, is one such product and is described as "being considered a high quality product" (page 1540). Therefore, it would have been obvious to one of ordinary skill to use said grapes in, the liquor of Suntory, in order to produce a beverage which would be regarded as "high quality".

Herraiz also identifies in Table 1, that the Pisco intrinsically possesses an acetic acid in an amount of 100 mg/l (100ppm) of absolute ethanol.

**Regarding claim 2**, although the combination of Suntory in view of Herraiz discloses a maca extract alcoholic beverage, neither reference discloses the amount of maca contained in the distilled liquor. However, since the instant specification is silent to unexpected results, the specific amount of maca contained in the distilled liquor is not considered to confer patentability to the claims. As the flavor is a variable that can be modified, among others, by adjusting the amount of maca contained in the distilled liquor, the precise amount would have been considered a result effective variable by one having ordinary skill in the art at the time the invention was made. As such, without showing unexpected results, the claimed amount cannot be considered critical. Accordingly, one of ordinary skill in the art at the time the invention was made would have optimized, by routine experimentation, the amount of maca contained in the distilled liquor in Suntory to obtain the desired flavor (In re Boesch, 617 F.2d. 272, 205 USPQ 215 (CCPA 1980)), since it has been held that where the general conditions of the claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. (In re Aller, 105 USPQ 223).

**Regarding claims 9-13 and 15**, Suntory in view of Herraiz discloses a distilled liquor product made from Muscat grapes with an extract of maca, wherein the acetic acid content is 100 mg/l (100ppm) of absolute ethanol, contains lemon and lime juice, and rose hip extract. Therefore, given the combination of Suntory in view of Herraiz is identical to the presently claimed method, the combination of the references would naturally decrease the odor of maca extract contained in the beverage.

**8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suntory News Release No. 8691 in view of Herraiz et al., "*Analysis of wine distillates made from Muscat grapes (Pisco) by multidimensional gas chromatography and mass spectrometry.*" in further view of Ogawa et al. JP 2004-000171.**

Suntory and Herraiz are applied as discussed above for claim 1. Both references are silent to the extraction of maca. Ogawa teaches the addition of alcoholic extracted maca into food products (abstract). The maca was extracted with ethanol at room temperature ($25^0$C) or at $40^0$C to raise the extraction efficiency [0020]. Given Ogawa's teaching of the alcohol extracted maca being a functional food which increases blood levels of growth hormones and stamina and the ability of the plant to prevent the decrease in physical strength, and the teaching that it can be provided in liquids and solutions [0021, 0060], one of ordinary skill in the art would have been motivated to extract the maca using ethanol as taught by Ogawa and incorporate it into the beverage of Suntory.

9. **Claims 8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suntory News Release No. 8691 in view of Herraiz et al., "*Analysis of wine distillates made from Muscat grapes (Pisco) by multidimensional gas chromatography and mass spectrometry.*" in further view of Gonzales et al. US. Pub 2006/0147600.**

**Regarding claim 8**, Suntory and Herraiz are applied as discussed above for claim 1. Both references are silent to the beverage being carbonated. Gonzales teaches a carbonated beverage product [abstract] containing maca. It would have been within the ambit of one of ordinary skill

to carbonate the beverage of Suntory in order to produce a beverage which has a "fizzy" effect and would add a pleasant mouth feel to the beverage.

**Regarding claim 14**, Suntory and Herraiz are applied as discussed above for claim 9. Both references are silent to the beverage being carbonated. Gonzales discloses the use of carbon dioxide [0045] in the maca beverage for stabilization. Therefore, it would have been obvious to one of ordinary skill in the art to use carbon dioxide in Suntory for stabilization which would necessarily produce carbonic acid since it will intrinsically form.

***Conclusion***

10. Examiner relied upon oral translation for Suntory News Release.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LELA S. WILLIAMS whose telephone number is (571)270-1126. The examiner can normally be reached on Monday to Thursday from 7:30am-5pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LELA S. WILLIAMS
Examiner, Art Unit 1787

/L. S. W. /

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1787